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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
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OIPE MAY 19 2006 PATENT & TRADEMARK OFFICE

ATTORNEY DOCKET NO. 10021301-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Michael P. Caren, et al.

Serial No.: 10/722,228 **Examiner:** Robert Thomas Crow

Filing Date: November 25, 2003 **Group Art Unit:** 1634

Title: METHODS AND APPARATUS FOR ANALYZING ARRAYS

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- [x] Response/Amendment
- [ ] Petition to extend time to respond
- [ ] New fee as calculated below
- [ ] Supplemental Declaration
- [x] No additional fee (Address envelope to "Mail Stop Amendments")
- [ ] Other: (Fee $_____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	$ 0
☐ FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 360	$ 0
EXTENSION FEE	1ST MONTH 120.00 ☐	2ND MONTH 450.00 ☐	3RD MONTH 1020.00 ☐	4TH MONTH 1590.00 ☐		$ 0
					OTHER FEES	$ 0
					TOTAL ADDITIONAL FEE FOR THIS AMENDMENT	$ 0

Charge $0 to Deposit Account **50-1078**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-1078** pursuant to 37 CFR 1.2 5. Additionally please charge any fees to Deposit Account **50-1078** under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,
Michael P. Caren, et al.
By Theodore J. Leitereg
Theodore J. Leitereg
Attorney/Agent for Applicant(s)

Reg. No. 28,319

Date: May 16, 2006

Telephone No. 408-553-4377

I hereby certify that this correspondence is being Deposited with the United States Postal Service as First class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

Date of Deposit: May 16, 2006

Typed Name: Theodore J. Leitereg

Signature: Theodore J. Leitereg

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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on May 16, 2006.

Signature Theodore J. Leitereg **Date** 5/16/06

Name: Theodore J. Leitereg

PATENTS
Attorney Docket No. 10021301-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael P. Caren, *et al.*

Serial No.: 10/722,228 Group Art Unit: 1634

Filed: November 25, 2003 Examiner: Robert Thomas Crow

Title: METHODS AND APPARATUS FOR ANALYZING ARRAYS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Response to Restriction Requirement

This paper is responsive to the Restriction Requirement in the Office Action dated May 1, 2006, from the U.S. Patent and Trademark Office in the above-identified patent application.

Restriction Requirement

Restriction was required under 35 U.S.C. §121 as follows:

Group I – Claims 1-11, drawn to fluidic devices, classified in class 435, subclass 283.1.

Group II – Claims 12-25, drawn to methods for conducting binding reactions, classified in class 435, subclass 6.

In making the Restriction Requirement, a determination was made in the Office Action that the inventions of Groups I and II are distinct each from the other.

According to M.P.E.P. 802.01 the term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (emphasis in original). Accordingly, in making the restriction requirement the Office Action is acknowledging at least implicitly that the inventions of the aforementioned groups are separately patentable over one other. If this were not the case, then the restriction requirement would not be proper.

Furthermore, it follows from the above that art (if such art exists) indicating that the invention of one of the groups is known or would have been obvious would not extend to a holding that the inventions of the other groups are known or would have been obvious. For example, art that might anticipate or render obvious a device for conducting binding reactions as set forth in, for example, claim 1 (and claims depending therefrom) would not render known or obvious a method comprising using the device according to claim 1 for conducting binding reactions as set forth in, for example, claim 12 (and claims depending therefrom) or vice versa. Again, if this were not the case, then the restriction requirement with respect to those claims would not be proper.

In response to and as required by the Restriction Requirement, Applicant elects the invention of Group I, claims 1-11, with traverse. Applicant reserves the right to file divisional patent applications to the subject matter that the Office Action has determined to be patentably distinct and separately patentable.

Product and Process Claims

The Office Action noted that restriction was required between product and process claims. Applicant acknowledges the indication in the Office Action that, where product claims are elected (such as elected above) and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of M.P.E.P. §821.04. Method claims 12-21 already are dependent from device claim 1 and, thus, fulfill the above requirement with

respect to withdrawn process claims (although such claims are not officially withdrawn). Claim 22 is currently independent and claims 23-25 depend therefrom.

Respectfully submitted,

Theodore J. Leitereg
Attorney for Applicant
Reg. No. 28,319

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